

REMARKS

I. Introduction

Claims 1-42 are pending in this application. Claim 42 has been rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Claims 1-25, 27-32, 34-39, 41 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Busche et al. (U.S. Published Appln. 2003/0055707, hereinafter "Busche") in view of Hines et al. (U.S. Patent 6,396,413, hereinafter "Hines"). Claims 26, 33 and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Busch in view of Hines, and further in view of the Duhamel et al. (U.S. Patent 5,541,585, hereinafter "Duhamel").

As discussed in further detail below, it is respectfully submitted that, (1) claim 42 complies with 35 USC §112, first paragraph, since the present application as filed demonstrates that the applicant possessed the invention of claim 42, and (2) the Examiner has failed to establish a *prima facie* case for the obviousness of the presently pending claims.

II. Claim 42 complies with 35 USC §112, first paragraph.

Paragraphs [0035] through [0040] of the present application disclose receiving transmitted ID signals in a monitor 32 from transmitters located in proximity to respective products, as recited in claim 37. Claim 42, which depends directly from claim 37, recites that the wireless receivers (reading on monitor 32) are provided with a GPS receiver. This is clearly disclosed by paragraph [0077] of the present application. Since the purpose of a GPS receiver is to receive GPS signals, it is evident that the disclosure of the present application discloses a monitor 32 that receives both GPS signals and transmitter ID signals. It is respectfully submitted, therefore, that claim 42 is supported by the present application.

III. The Examiner has Failed to Establish a *Prima Facie* Case for Obviousness of the Claims.

The examiner bears the burden of establishing a *prima facie* case that the claims are obvious over the cited references. "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of a patent." *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In order to establish that the claimed invention is obvious under 35 USC §103, the Examiner is obligated (1) to determine, "the scope and content of the prior art," (2) to ascertain, "differences between the prior art and the claims at issue," and (3) to resolve, "the level of ordinary skill in the pertinent art." "Against this background, the obviousness or nonobviousness of the subject matter is determined." *Graham v. John Deere*, 148 USPQ 459, 467 (S.Ct. 1966).

Level of Ordinary Skill in the Art

The Office Action fails to cite any evidence whatsoever with regard to the level of ordinary skill in the art, and also fails to make any findings at all concerning the level of ordinary skill in the art. For these reasons alone the Examiner has failed to establish a *prima facie* case of obviousness of *any* of claims 1-42.

The Scope and Content of the Prior Art; Differences between the Prior Art and the Claims at Issue

With regard to claims 1, 3 and 23, the Office Action asserts Busche discloses that, "each receiver receives respective ones of the location signals that associated [sic] with the product only when participants in a vicinity [sic] of each of the product locations." See paragraph 5 of the Office Action. Applicants do not see where the Busche reference discloses this feature of the claimed invention in the portions of this reference cited by the Examiner and so respectfully

submit that the Examiner has failed to carry out the requirement of determining the scope and content of the prior art. Moreover, by failing to demonstrate that the prior art discloses the claimed feature of a “wireless receiver ... operative to receive respective ones of the location signals only when in a vicinity of each of the locations,” the Examiner has failed, as required by law, to ascertain the differences between the prior art and the claims at issue. It is respectfully submitted, therefore, that the Examiner has failed to establish a *prima facie* case for the obviousness of these claims for these additional reasons.

“Against this background, the obviousness or nonobviousness of the subject matter is determined.”

Since the necessary background has not been established, the Examiner is not in a position to establish the obviousness of the claimed invention.

Moreover, the Examiner’s attempt to do so based on the flawed record of the outstanding Office Action, is further defective for the following reasons.

Even if the Office Action had demonstrated that all of the claimed elements were present in the prior art (which it has failed to do), that would not be sufficient to establish a *prima facie* case for the obviousness of the claims. It is also necessary to establish the *reasons* why one of ordinary skill in the art would be motivated to combine such elements to render the claimed invention obvious. See *In re Kahn*, 78 USPQ2d, 1329, at 1335 (Fed. Cir. 2006).

Here the Office Action states:

It would have been obvious of [sic] one having ordinary skill in the art at the time of the claimed invention is made [sic] to have a receiver that carried [sic] on the person as suggested by Hines, to [sic] the participants in a market research study of Busche, for the purpose that every customer in the retail environment would be monitored for better accuracy in market research study [sic], not just monitor the ones that need to use shopper’s basket [sic]. See the sentence bridging pages 3 and 4 of the Office Action.

As best applicants can understand this purported reason for combining the elements of Busche and Hines, one of ordinary skill in the art would think it practical to require all customers entering a retail store to wear a monitor to track their movements within the store. Such thinking defies a common sense understanding of human nature. The retail store's business would suffer from a severe loss of customers if such a requirement were to be imposed, precisely the opposite of what the store's owner seeks to achieve by monitoring movements within the store.

The reason advanced by the Examiner for demonstrating the obviousness of combining the elements of Busche and Hines is plainly absurd. All that is obvious is that the Office Action has failed to establish a *prima facie* case for the obviousness of claims 1, 3 and 23.

It is respectfully submitted, therefore, that claims 1, 3 and 23 are patentable over the prior art and are in condition for allowance.

Dependent Claims 2, 4, and 24-29

Each of these claims depends from a respective one of claims 1, 3 and 23. Accordingly, it is respectfully submitted that these claims are patentable over the prior art, and are in condition for allowance.

Claims 5 and 14-18

On page 4 of the Office Action, the Examiner asserts that Busche discloses, "Providing a portable monitor (attached to each shopping basket) adapted to be carried by each of a plurality of customers in a retail environment . . ." This statement is internally inconsistent: if the monitor is attached to a shopping basket, it is clearly *not* adapted to be carried by a customer. Therefore, the Office Action fails to correctly determine the scope and content of the prior art and fails to establish a *prima facie* case for the obviousness of claims 5 and 14-18.

In addition, the Office Action fails to properly determine the differences between the prior art and the claims at issue, since it fails to properly characterize their limitations. Each of claims 5 and 14-18 recites, "providing a portable monitor to each of a plurality of panelists participating in a customer behavior study to be worn thereby." For this additional reason, the Office Action fails to establish a *prima facie* case for the obviousness of claims 5 and 14-18.

Furthermore, with respect to claims 5 and 14-18, the Examiner advances the same reason for combining the elements of Busch and Hines as in the case of claims 1, 3 and 23. As explained above, this purported reason is merely absurd, and so cannot suffice to establish the obviousness of claims 5 and 14-18.

Dependent Claims 6-12 and 19-21

Each of these claims depends from a respective one of claims 5 and 14. Accordingly, it is respectfully submitted that these claims are patentable over the prior art, and are in condition for allowance.

Claims 13 and 22

On page 7 of the Office Action, the Examiner states that Hines discloses, "a relational database storing data representing consumer behavior in a commercial environment." However, the Office Action does not provide any citation to any portion of the Hines reference to support this assertion, and applicants can only find a reference to a "correctional facility" in Hines as an exemplary "specified area" to be monitored. See column 1, lines 1-19. Accordingly, the Examiner has failed to correctly determine the scope and content of the prior art in connection with his rejection of claims 13 and 22, and has, thus, failed to establish a *prima facie* case for the obviousness of these claims.

The Office Action recognizes that neither reference discloses either the first table or the second table as specified in each of claims 13 and 22. In an attempt to establish *prima facie* that these elements are obvious over the prior art, the Examiner took official notice of databases that store data in memory, that a database can be organized as multiple registers and that each register can store “specific data”. While applicants do not take issue with the facts for which the examiner has taken official notice, they also observe that the Examiner has failed to properly ascertain the differences between such prior art and the claims at issue, as required by law.

More specifically, the Office Action fails to acknowledge the “first table” of each of claims 13 and 22 storing records including either data representing a wireless transmitter positioned in a commercial establishment or a location therein, along with data indicating a location of such transmitter therein or data representing a position of such location in a coordinate system. Nor does the Office Action acknowledge the “second table” of each of claims 13 and 22 storing records representing a consumer carrying a portable monitor and either a transmitter from which the monitor received transmitter data or coordinates representing a position of the consumer. Therefore, the Office Action has failed to properly ascertain the differences between the prior art and claims 13 and 22, and so fails to establish a *prima facie* case for their obviousness.

Claims 30-32

With respect to claims 30-32, the Examiner advances the same reason for combining the elements of Busch and Hines as in the case of claims 1, 3 and 23. As explained above, this purported reason is merely absurd, and so cannot suffice to establish the obviousness of claims 30-32.

Dependent Claims 33-36

Each of these claims depends from claim 30. Accordingly, it is respectfully submitted that these claims are patentable over the prior art, and are in condition for allowance.

Claim 37

With respect to claim 37, the Examiner advances the same reason for combining the elements of Busch and Hines as in the case of claims 1, 3 and 23. As explained above, this purported reason is merely absurd, and so cannot suffice to establish the obviousness of claim 37.

Dependent Claims 38-42

Each of these claims depends from claim 37. Accordingly, it is respectfully submitted that these claims are patentable over the prior art, and are in condition for allowance.

In view of the foregoing, it is respectfully submitted that the rejection of pending claims 1-42 should be withdrawn. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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